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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DCKET NO.	CONFIRMATION NO.
09/902,727	07/12/2001	Arpan P. Mahorowala	YOR92000064US1	9512

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EXAMINER

KOVACEK, CHRISTY L.

ART UNIT PAPER NUMBER

2822

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/902,727

Applicant(s)

MAHOROWALA ET AL.

Examiner

Christy L. Novacek

Art Unit

2822

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY (check either a) or b)

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☒ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Advisory Action

This office action is in response to the after-final response, information disclosure statement, and declaration made under 37 CFR 1.131 filed November 24, 2003.

Information Disclosure Statement

The information disclosure statement filed November 24, 2003 fails to comply with 37 CFR 1.97(d) because it lacks a statement as specified in 37 CFR 1.97(e). It has been placed in the application file, but the information referred to therein has not been considered.

Response to Arguments

Applicant's arguments filed November 24, 2003 have been fully considered but they are not persuasive.

Regarding the rejection of claims 1-26 and 31 under 35 USC 112, second paragraph, applicant argues that the rejection is improper because allegedly, a "person of ordinary skill in the art would understand 'tuned polymer' from the context of the disclosure" (pg. 8 of applicant's response). To support his assertion, applicant states, "Given the disclosure of suitable type of polymer and suitable properties, a skilled artisan would readily be able to select an appropriate polymer for the resist." However, whether or not someone would be able to select an appropriate polymer for the resist based on applicant's disclosure is not the issue which warrants the 112, second paragraph rejection. The term "tuned polymer", because the definition thereof, has not been disclosed in applicant's specification, is deemed so ambiguous that one of ordinary skill in the art would not know if they were infringing upon applicant's claim or not. As is stated in the MPEP, "If the language of the claim is such that a person of ordinary skill in

the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the claim under 35 U.S.C. 112, second paragraph would be appropriate.” Evidence that the term “tuned polymer” is not commonly known in the art is that a search conducted by the Examiner of the database of US Patents and US Patent Application Publications found only 1 other patent and the publication of that patent’s application, which used the term “tuned polymer”. And in that instance, the term was used to describe a “mechanically tuned polymer grating”, thus the term in this patent was used in a way completely differently from that of the applicant. Further in support of their argument that a person of ordinary skill in the art would understand the meaning of “tuned polymer”, applicant states, “the concept of a tuned polymer was disclosed in the scientific literature in Lin et al., *A High Resolution 248 nm Bilayer Resist*”. However, nowhere in the Lin et al. reference referred to by applicant does the term “tuned polymer” appear. Thus, the rejections of claims 1-26 and 31 under 35 USC 112, second paragraph are maintained.

Response to Declaration filed under 37 CFR 1.131

The Declaration filed under 37 CFR 1.131 on November 24, 2003 will not be considered because it has been filed after a final rejection of the claims and has not been filed for the purpose of overcoming a new ground of rejection made in the final rejection. In relevant part, the MPEP section 715.09 states, “Affidavits or declarations under 37 CFR 1.131 must be timely presented in order to be admitted. Affidavits and declarations submitted under 37 CFR 1.131 and other evidence traversing rejections are considered timely if submitted:

(A) prior to a final rejection;

(B) before appeal in an application not having a final rejection; or

(C) after final rejection and submitted

(1) with a first reply after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection, or

(2) with satisfactory showing under 37 CFR 1.116(b) or 37 CFR 1.195, or

(3) under 37 CFR 1.129(a).”

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christy L. Novacek whose telephone number is (703) 308-5840 ((571) 272-1839 as of January 7, 2004). The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amir Zarabian can be reached on (703) 308-4905 ((571) 272-1852 as of January 7, 2004). The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

CLN
December 4, 2003

